

### **REMARKS**

#### ***Formal Matters***

Applicants thank the Examiner for considering the references submitted with the Information Disclosure Statements filed on June 3, 2005, and August 10, 2006.

Applicants thank the Examiner for acknowledging the claim to foreign priority and for acknowledging receipt of a certified copy of the priority documents.

#### ***Specification***

The Examiner has requested the Applicant to update the status of all parent priority applications in the first line of the specification.

Applicants have amended the specification to recite a cross-reference to the priority application in the first line of the description.

#### ***Objection to the Drawings***

The informalities in the drawings have been fixed as shown in the Amendment to the Drawings sections of this response. Hence, the examiner is requested to withdraw the objection.

#### ***Claims***

Claims 1, 9, 11, and 19 are all the claims pending in the application.

#### ***Prior Art Rejections***

Claims 1 and 9 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Iwai et al. (USPN 6,114,911), hereinafter "Iwai".

For at least the following reasons, Applicants respectfully traverse the rejection.

**Independent Claim 1**

Claim 1 recites, *inter alia*, an amplifying circuit comprising an amplifier amplifying a signal received through an input terminal, and outputting the signal through an output terminal. Claim 1 further recites, *inter alia*, a control circuit turning at least one of an input impedance and an output impedance of said amplifier into a high impedance. The Examiner contends that Iwai teaches or suggests all the features of claim 1.

The Examiner contends that Iwai discloses an input terminal 1 in Figures 1 and 2. See Office Action page 3. The Examiner further contends that terminal 2 in Figures 1 and 2 of Iwai corresponds to the claimed output terminal. See Office Action page 3. The element 2 in Figures 1 and 2 in Iwai corresponds to an input side Balun circuit. See col. 3 line 33 in Iwai. Therefore, element 2 in Iwai does not anticipate the claimed output terminal of claim 1.

The Examiner also contends that circuits 3 and 7 in Figures 1 and 2 in Iwai correspond to the claimed control circuit and that circuits 3 and 7 inherently turn at least one of an input impedance and an output impedance of said amplifier into a high impedance. See Office Action page 3. The Examiner however does not indicate which element in Iwai corresponds to the claimed amplifier. The Examiner further states that a high impedance occurs when the switches are on. See Office Action page 3.

Applicants submit that Iwai does not teach or suggest a claim limitation that at least one of an input and output impedance of said amplifier are turned into a high impedance. According to the Examiner, turning switch 3 on will make the input impedance of the amplifier inherently high and turning switch 7 on will make the output impedance of the amplifier inherently high. Iwai discloses that turning switch 3 on will result in the input signal to pass through the transistor TR3 and be grounded. See Iwai col. 7 lines 20-25. This does not necessarily make the input

impedance of the amplifier high. Evidence of inherency in a reference “must make it clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” Continental Can Co. USA Inc. v. Monsanto Co., 948 F.2d 1264, 1269 (Fed. Cir. 1991) (emphasis added). “Inherency, however may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” Id. (citing In re Oelrich, 666 F.2d 578, 581 (fed. Cir. 1981) (quoting Hansgig v. Kemmer, 102 F.2d 212, 214 (C.C.P.A. 1939))) (emphasis in original); see also Scaltech Inc. v. Retec/Tetra L.L.C., 51 U.S.P.Q.2d 1055, 1059 (Fed. Cir. 1999); and In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Similarly, Iwai also does not teach or suggest that the output impedance is necessarily turned into a high impedance, when switch 7 is turned on.

Claim 1 further recites, *inter alia*, said control circuit is comprised of an inductor and a switch, said inductor and said switch are electrically connected in series to each other, and further electrically connected in an AC manner between said input or output terminal and a grounded voltage. Claim 1 also recites, *inter alia*, said switch is comprised of a field effect transistor, wherein said inductor has an inductance resonating in parallel with a parasitic capacity of said amplifier.

It is respectfully submitted that Iwai does not teach or suggest all the features of claim 1.

Hence, it is respectfully submitted that Iwai does not anticipate claim 1 and the Examiner is requested to withdraw the rejection.

#### **Dependent Claim 9**

Claim 9 is patentable at least by virtue of its dependency on claim 1. It is patentable also for reason of the features contained therein.

Claim 11 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Yoshizawa (USPN 5,862,461), hereinafter “Yoshizawa”.

For at least the following reasons, Applicants respectfully traverse the rejection.

**Independent Claim 11**

Claim 11 recites a feature of a control circuit turning at least one of an input impedance and an output impedance of said amplifying circuit into a high impedance. Claim 11 is thus patentable for at least the reasons submitted for claim 1.

Claim 11 further recites, *inter alia*, said control circuit is comprised of an inductor and a switch, said inductor and said switch are electrically connected in series to each other, and further electrically connected in an AC manner between said input or output terminal and a grounded voltage. Claim 1 also recites, *inter alia*, said switch is comprised of a field effect transistor, wherein said inductor has an inductance resonating in parallel with a parasitic capacity of said amplifier.

It is respectfully submitted that Yoshizawa does not teach or suggest the above features of claim 11. Therefore, Yoshizawa does not anticipate claim 11 and the Examiner is requested to withdraw the rejection.

Claim 19 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshizawa in view of Iwai.

For at least the following reasons, Applicants respectfully traverse the rejection.

Iwai does not make up for the deficiencies of Yoshizawa. Therefore, claim 19 is patentable. Claim 19 is also patentable by virtue of its dependency on claim 11.

**Support for Amendments to claims 1 and 11**

The subject matter introduced in claims 1 and 11 by this amendment is clearly supported *at least* by Figure. 5.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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